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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/468,254 | 12/20/1999 | TERRY P. MAHONEY | 10992003-1 | 3404 |

22879 7590 05/06/2004

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EXAMINER

DASTOURI, MEHRDAD

ART UNIT PAPER NUMBER

2623

DATE MAILED: 05/06/2004

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,254

Applicant(s) *m*

MAHONEY ET AL.

Examiner

Mehrddad Dastouri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed October 7, 2003, has been entered and made of record.
2. Objection to Claim 5 has been withdrawn in view of Applicants' amendment.

Response to Arguments

3. Applicants' arguments have been fully considered but they are not persuasive. Applicants argue in essence that prior arts of record () do not disclose the electronic document corresponding to the hardcopy can be retrieved for further processing according to the processing information also stored in the mark placed on the hardcopy of the document.

The Examiner disagrees and indicates that as depicted in Figures 2a, 2b (Items 121 and 122), 3 and 4, and disclosed in Column 8, Line 30 through Column 10, Line 27, the glyphs on the hardcopy contains identification information for retrieval and processing of the electronic document.

Regarding claim 22, claim language does not recite voice input annotation or processing be embodied in the mark placed on the hardcopy.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1, 3-17 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zdybel, JR. et al., (hereinafter Z686), U.S. 5,486,686, further in view of Yamaguchi et al., (hereinafter Yamaguchi), U.S. 6,400,392.

As per Claim 1, Z686 teaches: creating (Column 6, Lines 23-25) and storing (via filename, Column 6, Lines 59-62) the electronic document (element 32, Figure 2a);

placing a mark (glyph, Column 8, Lines 47-50) on the hardcopy corresponding to the stored electronic document (Column 8, Lines 52-67, Column 9, Lines 1-37), the mark containing identification information for retrieval of the stored electronic document (Column 9, Lines 38-67, Column 10, Lines 1-27) and processing information of the electronic document (ASCII, DDL, PDL digital encoding, Column 7, Lines 1-37, Column 9, Lines 38-67, Column 10, Lines 1-27);

viewing the hardcopy by an image capture device to capture an image of the hardcopy document (input scanner, Figure 2b, element 12, Column 9, Lines 46-51);

decoding ("machine readable" is equivalent to decoding, Column 8, Lines 44-47, Column 9, Lines 40-45, and Column 10, Lines 17-25) the mark from the image captured by the image capture device to determine identification information (Figure 2b, element 136) of the electronic document (Column 6, Lines 16-21) and processing information (appearance related, Column 9, Lines 58-67);

retrieving (recovered, Column 9, Lines 47-49) the electronic document based on the determined identification information of the electronic document; and

processing the electronic document according to the identification information (Column 10, Lines 1-13).

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However, Z686 does not teach activating an image capture device via motion detection. But Yamaguchi teaches:

viewing the hardcopy by an image capture device ("camera for shooting a document", Column 18, Line 56) to capture an image of the hardcopy document wherein the image capture device is activated by waving ("movement of a hand", which clearly would be holding the document) a copy of the hardcopy (Column 15, Lines 22-25, Figure 20) document in front of the image capture device (camera, Column 15, 1. 24 and figure 27);

It would have been obvious to one of ordinary skill in the art to use the document sensing technology of Yamaguchi's system (Column 5, Line 64 through Column 6, Line 1) in the system of Z686 to alleviate users from using a flat bed scanner and using more efficient and up-to-date scanner technology. Furthermore, Z686 appreciates that flat bed scanners or facsimile devices are not the only devices that can be used to collect and reproduce a document image (Column 6, Lines 44-55). Additionally, Z686 acknowledges that input scanners have no mechanisms for recovering data related to the document other than what can be ascertained from the documents appearance (Column 8, Lines 25-30), so accordingly any image capture device can be used such as the document pickup camera (see Yamaguchi, Figure 27).

As per Claim 3, Z686 teaches: wherein the step of placing a mark on the hardcopy is performed by creating the mark at the time of creation of the electronic document (Figure 2a, 105) and wherein the hardcopy, with the mark, is printed from the electronic document (Figure 2a, 15 via 46 and 48).

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As per Claim 4, Z686 teaches: wherein the step of placing a mark is performed by a printer that prints a digital mark on the hardcopy document (Column 8, Lines 47-50).

As per Claim 5, Z686 teaches: wherein the step of placing a mark is performed by a copying the hardcopy having a mark to create another hardcopy with the mark ("further augmented" Column 10, Lines 56-67).

As per Claim 6, Z686 teaches: wherein the mark is a bar code (Figure 1b, Column 8, Lines 52-55).

As per Claim 7, Z686 teaches:

wherein the mark is a two dimensional bar code (Figure 1b, Column 8, Lines 55-60).

As per Claim 8, Z686 teaches:

wherein the step of processing the document includes retrieving the document for viewing (Column 6, Lines 23-25, personal computers typically have a monitor).

As per Claim 9, Z686 teaches:

wherein the step of processing the document includes the step of mailing the document by electronic mail (Figure 2a, 42, Figure 2b, element 41, Column 7, Lines 18-24).

As per Claim 10, Z686 teaches: wherein the step of processing the document includes the step of the printing the document (Figure 2a, elements 46, 48, 16 and 15).

As per Claim 11, Z686 teaches: wherein the step of processing the document includes the step of making a copy of the electronic document (Figure 2b, element 54).

As per Claim 12, Z686 teaches: wherein the mark is machine readable code formed on a substrate on which the hardcopy is printed (Column 8, Lines 49-50, printed on the hardcopy).

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As per Claim 13, Z686 teaches: wherein the machine readable code is formed using font pattern modification including one of a half-tone screen (screen frequency, Column 9, Line 64), inter-character spacing modification (Column 8, Lines density), and dithering patterns (rotation of halftoned images, Column 9, 1. 64).

As per Claim 14, Z686 teaches:

wherein the machine readable code is formed on a particular location (predetermined region) in the hardcopy document (Column 9, Lines 27-37).

As per Claim 15, Z686 teaches: wherein the mark is a digital mark (digital data form, Column 9, Line 47).

As per Claim 16, Z686 teaches:

wherein the step of placing a mark is performed by a printing press (printing processes, Column 11, Line 5) that prints the mark during bulk printing (Column 10, Line 62 through Column 11, Line 9). Z686 teaches that reprographic devices include photocopiers and electronic printer, which are obviously capable of printing in bulk.

It would have been obvious to one of ordinary skill in the art to use a bulk printer to output documents that may need wide dissemination particularly in the scheme of multiple authors and editors as taught by Z686 and Yamaguchi.

As per Claim 17, Z686 teaches: wherein the step of processing the electronic document includes invoking a software application (recognition software, Column 7, 1. 66-Column 8, 1. 4, Column 9, Lines 46-67) to process the electronic document.

As per Claim 20, it recites substantially the same limitations as Claim 1 above and analogous remarks apply.

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As per Claim 21, Z686 teaches: wherein the processing unit processes the electronic document by one of sending by electronic mail (Figure 2a, 42) , printing (Figure 2a, elements 46, 48, 15 and 16), or copying (well known to copy electronic files) of the electronic document.

As per Claim 22, it recites substantially the same limitations as Claims 1 and 20 above and analogous remarks apply, except for the following, which is taught by Z686: receiving a voice input indicative of an annotation (Column 6, Lines 44-49).

6. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Z686 and Yamaguchi, further in view of Daniele, US 5,444,779.

As per Claim 18, neither Z686 nor Yamaguchi teach using a mark based upon intellectual property rights associated with the document.

However, Daniele teaches:

wherein the step of processing the electronic document includes identifying and processing based on any intellectual property rights associated with the hardcopy documents (Column 9, Lines 58-60, glyph codes that indicate copyright).

It would have been obvious to one of ordinary skill in the art to use a display to present the document (glyph copyright management features of Daniele) to protect the authors of certain documents as taught by Z686 (Figure 5) and Yamaguchi.

As per Claim 19, Z686 does not specifically allocating and calculating costs.

However, Daniele teaches:

wherein the step of processing the electronic document includes calculating and allocating revenues or costs associated with the hardcopy document (survey results of

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prior art, Figure 1 and "\$" in Figure 7). It would have been obvious to one of ordinary skill in the art to use the glyphs of Z686 and Yamaguchi as the glyphs in Daniele to record, track, and allocate the accrual of copyright royalties.

Other prior art cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent 5,428,694 to Betts et al;

U.S. Patent 5,521,991 to Bilings.

Information-based indicia program (IBIP); United States Postal Service.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mehrdad Dastouri whose telephone number is (703) 305-2438. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on (703) 308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**MEHRDAD DASTOURI
PRIMARY EXAMINER**

Mehrdad Dastouri

Mehrdad Dastouri
Primary Examiner
Group Art Unit 2623
May 2, 2004